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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,543	10/04/2001	Benjamin Eithan Reubinoﬀ	14418Z	1839

7590 08/18/2003

Scully, Scott, Murphy & presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER

CROUCH, DEBORAH

ART UNIT	PAPER NUMBER
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1632

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DATE MAILED: 08/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/970,543

Applicant(s)

REUBINOFF ET AL.

Examiner

Deborah Crouch, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-73 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 29-39, drawn to an enriched preparation of human embryonic stem cells, an undifferentiated human embryonic stem cell and methods of preparing undifferentiated human embryonic stem cells, classified in class 425, subclass 366 and 377.
- II. Claims 8-28 and 40-59 drawn to a differentiated committed human progenitor cell line, a neural progenitor cell, an enriched preparation of neural progenitor cells, methods of inducing somatic differentiation of stem cells and differentiated progenitor cells, neurons, astrocytes and oligodendrocytes classified in class 435, subclass 377.
- III. Claims 60-64, drawn to a method of producing an enriched preparation of human ES cell derived neural progenitor cells, classified in class 435, subclass 377.
- IV. Claims 65-73, drawn to a method of transplanting ES derived neural progenitor cells in a host, a method of producing a stable graft and a method of modifying a nervous system of a host, classified in class 424, subclass 93.2.

Inventions I and any of inventions II-IV are mutually exclusive and independent as the protocols for preparing undifferentiated human embryonic stem cells require materially different reagents than the protocol for inducing somatic differentiation of stem cells, methods of inducing somatic differentiation of stem cells, methods of producing an enriched preparation of human ES cell derived neural progenitor cells and a method of transplanting neural progenitor cells in a host. None of the methods are required for the implementation of any of the other methods.

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Inventions II and either II or IV are mutually exclusive and independent. The method of inventions II and either II or IV requires materially different and separate protocols than method of producing and enriched preparation of human ES cell derived neural progenitor cells and methods of transplanting neural progenitor cells in a host. None of the methods are required for the implementation of any of the other methods.

Inventions III and IV are mutually exclusive and independent. The method of producing and enriched preparation of human ES cell derived neural progenitor cells is not required for the methods of implanting neural progenitor cells in a host. Further, the protocols for inducing differentiation and for transplantation are materially different and separate.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is 703-308-1126. The examiner can normally be reached on M-Th, 8:30 AM to 7:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah J. Reynolds can be reached on 703-305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Deborah Crouch, Ph.D.  
Primary Examiner  
Art Unit 1632

dc  
August 14, 2003